

REMARKS

I. STATUS OF THE CLAIMS

Claims 1 and 3-44 are currently pending in this application. Claim 1 has been amended to be directed to make-up compositions. Support for this amendment can be found, for example, at page 1 of the specification.

II. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of claims 1 and 3-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,940,983 ("*Sartori*") in view of U.S. Patent No. 3,856,026 ("*Gaydos*") for the reasons disclosed at pages 2-4 of the Final Office Action. Applicants respectfully traverse this rejection for at least the reasons of record and for the reasons presented below.

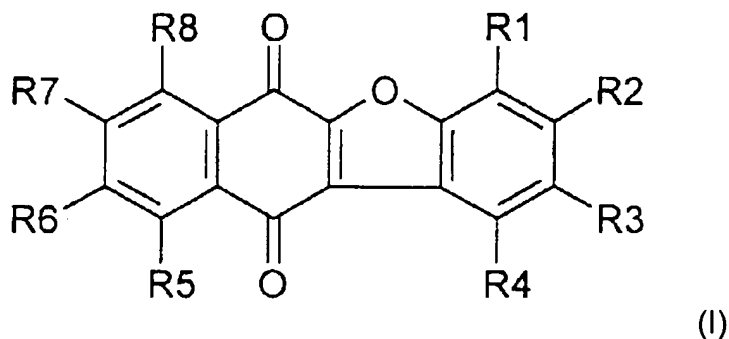
In response to Applicants' previous submission, the Examiner issued an Advisory Action maintaining this rejection. Applicants note that the Examiner did not address any of the substantive arguments made in that submission and respectfully request consideration of those arguments, as presented below.¹

Applicants' invention is not obvious over *Sartori* in view of *Gaydos*. As an initial matter, to establish a prima facie case of obviousness, the Examiner must show that three basic criteria have been met. See M.P.E.P. § 2143. Applicants submit that the Examiner has not and cannot show, at a minimum, that (1) *Sartori*

¹ The Examiner did make reference to a motivation to combine reference (Advisory Action at 2); however, Applicants submit that this was non-responsive to the
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and *Gaydos* in combination teach or suggest all of the claim limitations, (2) a suggestion or motivation in *Sartori*, *Gaydos*, or in the knowledge generally available to one of ordinary skill in the art exists to modify the teachings of *Sartori* and *Gaydos* in order to recreate Applicants' claimed invention, and (3) a reasonable expectation of success exists for the combination of *Sartori* and *Gaydos*. See M.P.E.P. §§ 2143.01, 2143.02, and 2143.03.

Applicants claims recite make-up compositions (claims 1, 3-24), make-up products (25-32), and methods of making cosmetic composition (33-44) comprising a cosmetically acceptable medium and/or at least one ingredient/coloring agent chosen from compounds of formula (I) and salts thereof:



Sartori discloses a series of halogen substituted dinaphthofurandiones. For example, *Sartori* discloses 8-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione and 11-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione. See col. 2, lines 45-65. However, *Sartori* does not teach or suggest that these compounds are suitable for cosmetic compositions and make-up products, and, hence, not the cosmetically acceptable

(...continued)

arguments presented regarding motivation to modify or lack of reasonable

(continued...)

medium of the claims. *Satori* merely discloses that the compounds are useful as “disperse dyes for polyester fiber.” Col. 1, lines 42-44.

Gaydos discloses methods of applying flock, i.e., precision cut natural or synthetic fibers, to nails and eyes for cosmetic purposes. Col. 1, lines 5 - 56. The flock may be applied to an adhesive, which in turn has been applied to a sheet or film. Col. 2, lines 19-37. The flock-coated film may be applied to nail and eye surfaces. Col. 2, lines 45-55. *Gaydos* does not disclose the compounds of formula (I) or the cosmetically acceptable medium.

**A. When Combined, *Satori* and *Gaydos*
Do not Yield Applicants’ Claimed Invention.**

The Examiner suggests that “[i]t would have been obvious “to have used polyester fibers dyed with the compounds of *Satori* in cosmetic compositions as taught by *Gaydos* in order to benefit from polyester fibers in various colors with bright, strong color of good sublimation fastness as taught by *Satori*.” Final Office Action at 2-3. Applicants submit that *Satori* and *Gaydos*, whether alone or in combination, do not teach or suggest all of the claim limitations of independent claims 1, 25 and 33. First, neither reference teaches the “cosmetically acceptable medium” of claims 1 and 25. Second the combination, as argued, does not comprise the “at least one ingredient” of claims 1 and 25 and “at least one colouring agent” of claim 33. Accordingly, any composition resulting from the combination of *Satori* and *Gaydos* will be deficient in these respects.

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expectation of success.

With respect to a cosmetically acceptable medium, the Examiner has incorrectly asserted that *Gaydos* discloses a film-forming polymer. Final Office Action at 2. While *Gaydos* does disclose the use of a "film" as a carrier for its flock, *Gaydos*' "film" is neither (1) a film-forming polymer nor (2) a "cosmetically acceptable medium," as that term is used in independent claims 1 and 25, on page 23 of the present specification, and as used in the art.

In fact, *Gaydos* does not teach or suggest that this "film" is a film-forming polymer. *Gaydos*' use of "film" is in keeping with *Gaydos*' use of "sheet," merely a solid, flexible, planar substance, which *Gaydos* says can be cut to size. This stands in contrast with Applicants' description of a true "film-forming polymer." See specification at 20-21. The fact that *Gaydos*' film or sheet must have a pressure sensitive adhesive applied (col. 2, lines 23-25) also detracts from any conclusion that "film" means film-forming polymer.

Moreover, this "film" of *Gaydos* is not a cosmetically acceptable medium. The specification explains that film-forming polymers "may be dissolved or dispersed in the cosmetically acceptable medium" (specification at 20-21), i.e., the polymer IS NOT the cosmetically acceptable medium rather the medium may comprise the polymer.

With respect to "at least one ingredient" and "at least one colouring agent," the combination, as suggested by the Examiner, does not disclose a compound of formula (1) as an ingredient or colouring agent, as those terms are used in the specification.

The specification teaches that the compounds of formula (1) are similar, yet better than, the traditional pigments. See, e.g. specification at page 4, lines 19-22. Specifically, the compounds of formula (1), as used in the claimed compositions and compounds are present in solid form, which is consistent with the additional description of these compounds as "generally insoluble in water and very sparingly soluble in oils." *Id.* at page 5, lines 1 & 8-10.

This is contrary to the compositions and products, identified by the Examiner from the combination of *Satori* and *Gaydos*. As presented by the Examiner, the compound of formula (1) from *Satori* is used as a disperse dye to color the polyester fibers of *Gaydos*. Final Office Action at 2-3. Thus, it is no longer the compound of formula (1) which becomes a part of the claimed make-up composition, make-up product, or cosmetic composition, rather it is the dyed pieces of polyester.

For at least these reasons, Applicants maintain that the Examiner has not set forth a prima facie case of obviousness.

B. There is No Motivation to Modify *Gaydos*.

The Examiner has asserted that it would have been prima facie obvious "to have used polyester fibers dyed with the compounds of *Satori* in cosmetic compositions as taught by *Gaydos* in order to benefit from polyester fibers in various colors with bright, strong color of good sublimation fastness as taught by *Satori*."

Final Office Action at 2-3. In view of the fact that *Gaydos* does not teach or suggest all of the claim elements and limitations, there must be evidence of a motivation to modify *Gaydos* to render Applicants' claims obvious. With respect to independent

claims 1 and 25, Applicants submit that there is no motivation to replace one carrier (the "film") with another carrier ("the cosmetically acceptable medium").

Applicants respectfully remind the Examiner that, in moving from the prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious **to try**. See *e.g.*, M.P.E.P. § 2145, Section X, Subsection B. Rather, the proper test requires determining what the prior art would have led the skilled person **to do**. The Federal Circuit has given some examples of what would constitute an "obvious to try" modification based on the prior art. See In re O'Farrell, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). For example, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *Id.* at 1681 (citations omitted). In the present case, the cited references, at very best, gave general guidance to use general components in generic compositions. However, such general guidance is insufficient to support the addition of a cosmetically acceptable medium.

This is further highlighted by considering the stated objectives for *Gaydos*' invention. For example, it is unclear how any cosmetically acceptable medium can achieve the stated objective of providing a composition that "can be pre-cut or die-cut to form areas of any desired shape or size for easy application." *Gaydos* at col. 1, lines 18-20. In fact, the specification's recited suspensions, dispersions, emulsions, gels, lotions, etc. are inconsistent with such an objective and, thus, a *prima facie* case of obviousness cannot be made. M.P.E.P. § 2143.01 ("If proposed

modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion to motivation to make the proposed modification."

For at least this additional reason, Applicants maintain that the Examiner has not set forth a prima facie case of obviousness.

C. There is No Reasonable Expectation of Success from the Combination of *Satori* and *Gaydos*.

With respect to applying the dyes of *Satori* to the flock of *Gaydos*, the Examiner has asserted that there is a "benefit from polyester fibers in various colors with bright, strong color of good sublimation fastness" which provides the necessary motivation. Final Office Action at 2-3. Applicants submit, however, there is no evidence that such a combination would be successful, even assuming that all the limitations and elements are found in the proposed combination. Since claims 1 and 3-44 are directed to make-up compositions and methods of making compositions in the form of cosmetic compositions, make-up compositions, and make-up products, there must be evidence that the proposed combination would be successful as such compositions or product.

It is well known that manufacturers of cosmetic compositions, make-up compositions, and make-up products must conduct extensive testing, such as toxicity tests, to determine whether a composition is suitable for human usage.

Applicants submit that there is no evidence of predictability with regard to the use of *Satori's* dyes in the formation of a suitable composition and, hence no reasonable expectation of success. M.P.E.P. § 2143.02.

The Federal Circuit has stated that:

[t]he factual inquiry whether to combine references must be thorough and searching. It **must be based on objective evidence of record....** Thus the Board must not only assure that the requisite findings are made, based on evidence of record, **but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.**

In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (emphasis added). Hence, there must be objective evidence of a reasonable expectation of success, not mere conjecture. Even the specification does not offer an expectation of success. The specification explains that many coloring compounds, for example, are incompatible with cosmetic compositions because they may be unstable with respect to heat or pH, may bleed excessively, or may be unstable with respect to other pigments. Specification at 2-3. Nothing in the cited prior art suggests that this is not true with respect to *Satori's* dyes. Mere evidence of intense coloration is not enough to establish a reasonable expectation of success. M.P.E.P. § 2143.02 ("Obviousness does not require absolute predictability, however, at least some degree of predictability is required.")

For at least this additional reason, Applicants maintain that the Examiner has not set forth a prima facie case of obviousness. Accordingly, Applicants request that this rejection be withdrawn.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the claimed invention is not rendered obvious in view of the prior art references cited

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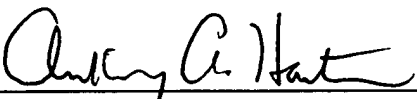
against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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